

REMARKS

This is a full and timely response to the outstanding non-final Office action mailed October 1, 2004 (paper no. 20040922). The Examiner has required the applicant to elect to prosecute one of five groups of claims identified in the Office Action. In response to the restriction requirement, applicant respectfully elects to prosecute the claims of Group I, corresponding to claims 1-15, with traverse, as set out hereafter.

First, in the interests of equity and fairness, applicant should be entitled to pursue different types of claims in the present application, particularly, apparatus claims and method claims, for the invention to fully protect the invention, because there is a different body of law pertaining to each of these different types of claims. The restriction requirement is therefore unfair to the applicant, because it will require the applicant to file and bear the additional cost and time delay associated with filing one or more divisional or continuing applications in order to cover each type of claim set.

Second, as provided in 35 U.S.C. § 121, restriction to one of two or more claimed inventions is proper only if the inventions are "independent and distinct." In its discussion of the propriety of restrictions, MPEP § 803 further provides that if the search and examination of two or more inventions can be made without "serious burden," the Examiner must examine them on the merits even if the claims are directed to distinct or independent inventions.

In the present case, Groups I and II, although not necessarily obvious in view of each other, are very similar in subject matter. Requiring the Applicant to file a divisional application in order to cover the method type claims is unfair to Applicant for the reasons listed above. Additionally, search and examination of these two claim groups can be made without a serious burden as evidenced by U.S. Patent No. 6,623,346, which was searched by the present examiner in the classes

cited for claim groups I and II in the Office Action. For at least this reason, applicant respectfully submits that the inventions described in these claims are not “independent” as defined in MPEP § 803 and that the restriction requirement therefore is improper as between Groups I and II.


In the present case, Groups I and III, although not necessarily obvious in view of each other, are very similar in subject matter. More specifically, each pertains to the processing of live objects.

In contrast with the statement of the Office Action that “invention III has a separate utility such as transporting **non-living** objects”, claim 19 of claim group III recites elements for “[a] device for receiving an isolated **live** object.” (Emphasis added). For at least this reason, applicant respectfully submits that the inventions described in these claims are not “independent” as defined in MPEP § 803 and that the restriction requirement therefore is improper as between Groups I and III. Indeed, it appears that a search for devices in these claim groups would be conducted within the *same class*. In such a situation, it clearly would not be overly burdensome on the Examiner to check for both of these “separate” inventions at the same time.

For at least the foregoing reasons, applicant respectfully traverses the restriction requirement and respectfully requests the Examiner to examine the claims of Groups I and III together. Applicant expressly reserves the right to present the non-elected claims, or variants thereof, in continuing applications to be filed subsequent to the present application. Should the Examiner have any questions regarding this response, the Examiner is invited to telephone the undersigned attorney.

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Respectfully submitted,


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